



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 09/414,547 | 10/08/1999 | TOKIMORI TOMITA | 122.1046cd | 3462 |
| 21171 | 7590 | 02/23/2010 | EXAMINER | |
| STAAS & HALSEY LLP | | | KARMIS, STEFANOS | |
| SUITE 700 | | | ART UNIT | |
| 1201 NEW YORK AVENUE, N.W. | | | PAPER NUMBER | |
| WASHINGTON, DC 20005 | | | 3693 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 02/23/2010 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

| | |
|--------------------------------------|--------------------------------------|
| Application No. 09/414,547 | Applicant(s) TOMITA ET AL. |
| Examiner STEFANOS KARMIS | Art Unit 3693 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 February 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 101-108.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☒ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). 2/5/2010

13. ☐ Other: _____.

/Stefanos Karmis/
Primary Examiner, Art Unit 3693

Applicant's amendment filed 12 February 2010 has been entered and an explanation of how the amendments are rejected is presented below.

Applicant has amended the preamble of the claims to recite that the computer is on a store side and the customer terminal is on a customer side. However, in response to applicant's arguments, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant has also amended the claims to recite that the customer identification is given so that a customer transaction can be performed. However customer transactions are taught in the prior art. Schultz teaches that the in-store computer system comprises an in-store data bank (database) for storing a plurality of files (column 9, lines 47-59). Schultz further teaches that the files include information related to consumers participating in a frequent shopper program and reward files containing information related to the purchase reward offer (column 9, lines 47-59). Schultz further teaches that the PMCS also includes a data bank which stores reward files and customer files identical the in-store data bank (column 9, line 60 thru column 10, line 6). Schultz also teaches that the customer file stores records of purchased items with associated rewards (column 10, lines 8-19). Therefore, Schultz teaches a "a customer database for stored cumulative points." Further, Schultz teaches sending a status report, usually monthly, to the customer that details the purchase of reward products and reward amounts that have already been earned (column 8, lines 42-67). The Examiner also notes that the status report is sent to the customer regardless of the customer's request since it comes on a time basis. Schultz fails to teach that the report is sent to a customer terminal after the customer identification and prior to performing a transaction by the customer.

Deaton also teaches the use of a customer database (column 68, steps 3-13). Deaton teaches dissemination of Point-Of-Sale coupons that are earned based on previous transactions and shopping history of the customer (column 67, lines 56 thru column 68, line 12; Examiner notes that the coupons are analogous to the reward certificates taught in Schultz). Deaton teaches using a checking account ID to identify the customer at the point of sale (column 68, lines 13-67, see steps 6-13). Deaton further teaches that the coupon reward and other incentives are made at the point of sale terminal and applied to the current purchase (column 69, lines 46 thru column 70, line 46).

Nichtberger teaches a paperless system for distributing, redeeming and clearing merchandise coupons in which a customer presents his special card before the checkout process begins and the in-store computer unit receives the customer's coupons from the CDR and applies the coupons to items as they are being purchased before totaling the purchase amount (column 17, lines 30-61). Therefore Nichtberger teaches that the coupon are delivered to the user after identifying the user (when the user's card is scanned) and prior to performing the transaction (final payment and completion of sale). Further Nichtberger teaches that coupons are retrieved when a special card or receipt number has been scanned (column 17, lines 49-52). The special card is used to identify the customer (column 17, lines 30-48). Further, Nichtberger teaches that the processor requests the corresponding list of coupons, not the customer (column 17, lines 49-53). Similarly, Applicant's claims require identifying the customer prior to sending the customer the account balance. Further, something has to request the point balance, like the system.

Any other amendments to the claims are substantially similar to limitations that have already been addressed.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz to include having the customer access their reward coupons as items are being purchased (before the purchase total) as taught by Deaton and Nichtberger because it allows the customer to take advantage of earned coupons/rewards through their shopping history (previous transactions) at the point of sale when items are being purchased rather than having to make another trip back to the store or having to remember to bring the physical coupon/reward. There is sufficient motivation combine the teachings of Schultz with Deaton and Nichtberger because the reward certificates taught by Schultz act as earned coupons that can be applied for a discount or free gift. Schultz teaches that the reward certificate can be a voucher to be redeemed at the store for credit towards product purchases and is therefore applied similarly to the coupons taught by Deaton and Nichtberger.